



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/893,460

06/29/2001

Joseph G. Gatto

055444-0311366

7177

909

7590

09/16/2008

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

09/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/893,460	Applicant(s) GATTO, JOSEPH G.	
	Examiner Narayanswamy Subramanian	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/13/03, 8/14/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's request for continued examination of June 3, 2008. Amendments to claims 1, 4-5, 13-17, 20-38, and 40 have been entered. Claims 1-40 are pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1- 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 40 recite the limitation "one predetermined alert condition". This limitation lacks antecedent basis because the step of predetermining an alert condition has not been positively recited in the preceding steps. The limitation "to determine when one or more alert conditions are satisfied" is interpreted as an intended use of the analyzing step. Hence it is not clear if the alert conditions are actually predetermined and if one or more alert conditions are satisfied. Hence the scope of the claim is not clear. Claims 2-39 are rejected by dependency on a rejected independent claim. Appropriate correction is required.

Claims 1-39 recite the limitation "means for storing, in a data repository on a per analyst basis". However it is not clear if the data repository is claimed as a part of the system. It is also not clear if the Applicants are invoking the 35 USC 112, sixth paragraph for the purpose of interpreting these claims.

Art Unit: 3691

Claim 2 recites “wherein one alert condition is based on”. It is not clear as to alert condition the Applicants are referring to.

Claim 3 recites “detected cluster of estimate revisions”. This limitation lacks antecedent basis because the step of detecting cluster of estimate revisions has not been positively recited in the preceding steps.

Claim 4 recites “older than a date associated with the detected cluster of estimate revisions”. The metes and bounds of this limitation are unclear.

Claim 5 recites “a predetermined period of time older than a date associated with the detected cluster of estimate revisions”. This limitation lacks antecedent basis because the step of predetermining a period of time older than a date associated with the detected cluster of estimate revisions has not been positively recited in the preceding steps. It is not clear as to what is the source of the predetermined period of time. Hence the metes and bounds of this limitation are unclear.

Claim 6 recites “a summary metric of a plurality of analysts' estimates by a predetermined value”. It is not clear as to what is the source of the “summary metric” and the “predetermined value”. Hence the metes and bounds of this limitation are unclear.

Claim 8 recites “a conditional summary metric qualified by at least one qualifying metric”. It is not clear as to what is the source of the “conditional summary metric” and the “qualifying metric”. Hence the metes and bounds of this limitation are unclear.

Claims 21-26, 32-33 and 37-39 recite the limitation “means for enabling a user to perform a function”. It is not clear as to what is the outcome of these limitations. For instance claim 21 recites “means for enabling a user to view all of the satisfied alert conditions associated

Art Unit: 3691

with the at least one analyst”. The limitation “to view all of the satisfied alert conditions associated with the at least one analyst” is interpreted as an intended use of the enabling step. There is no guarantee that the satisfied alert conditions associated with the at least one analyst has been viewed by the user. Enabling a user to perform a function is not the same as performing the function. Hence the scope of these claims are unclear.

Claim 40 also recites “analyzing the current estimate data to determine when one or more alert conditions are satisfied”. However it is not clear if this step is performed manually or on a computer. Hence the scope of the claim is not clear.

The rejections below are interpreted in view of the rejections above.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-40 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a **"new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof"** (emphasis added).

Claims 1-39 are drawn to “a system for monitoring analysts' estimates comprising: means for storing in a data repository, means for analyzing and means for issuing via a graphical user interface (GUI)”. A GUI is interpreted as software. The display device as stated is not a part of the claimed system. The data repository, as claimed, is not a structural element of the claimed system. Rather it is part of the function performed by the “means for storing”. Similarly the

Art Unit: 3691

display device, as claimed, is not a structural element of the claimed system. Rather it is part of the function performed by the “means for issuing”. Hence as such the claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101, that is a process, machine, manufacture, or composition of matter. The “means for” corresponds to software program elements and not tangible hardware components. Software program elements do not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101.

Claims 1-39 of the disclosed invention are inoperative and therefore lack utility.

Claims 1-39 merely recite elements of an apparatus or a system (“means for” corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

Claim 40 is drawn to “a computer-implemented method for monitoring analysts' estimates, comprising the steps of: storing, in a data repository on a per analyst basis, current

Art Unit: 3691

estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made; analyzing the current estimate data to determine when one or more alert conditions are satisfied; and issuing, via a graphical user interface displayed on a display device, an alert when at least one of the satisfied alert conditions further satisfy at least one predetermined alert condition for at least one analyst of the plurality of analysts”. As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

Art Unit: 3691

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”).

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. The steps of the claimed invention are not clear and specific enough to guarantee that the same results will be produced for a given set of inputs. The limitation “analyzing the current estimate data to determine when one or more alert conditions are satisfied” is not clear and specific enough to guarantee that the same results will be produced for a given set of inputs. This step is interpreted to include a manually performed step also and hence there is no guarantee that the performance of this step will yield the same results. It is not clear as to what is the concrete result of the claimed invention. In view of the ambiguities identified in the 35 USC 112, second paragraph rejections above, it is not clear if the results of the claimed invention are repeatable or predictable.

There is no useful, tangible and concrete result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

Art Unit: 3691

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. (US Patent 5,557,513).

Claim 40, Frey discloses a computer-implemented method comprising the steps of: storing data in a data repository (See Frey entire document especially Figure 1, Abstract, Column 4 lines 65-67); analyzing the data to determine when one or more alert conditions are satisfied (See Frey entire document especially Figure 1, Abstract, Column 5 lines 1-9); and issuing, via a graphical user interface displayed on a display device, an alert when at least one of the satisfied alert conditions further satisfy at least one predetermined alert condition (See Frey entire document especially Figure 1, Abstract, Column 5 lines 10-17).

Frey does not explicitly disclose data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made.

Official notice is taken that the feature of data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made is old and well known in the art. These estimates help investors stay informed

Art Unit: 3691

and make informed decisions about their investment portfolio. Support for the official notice can be found in Applicant's own (background of invention) specification Page 2 paragraph 2.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Frey to include these features. The combination suggests that investors would have benefited from being informed about the current earnings estimate on their investment and it would have helped them make informed decisions about their investment portfolio.

Note is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding obviousness or Official Notice, Applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

Response to Arguments

8. Applicant's arguments with respect to pending claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3691

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3691

September 15, 2008